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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,563	06/27/2003	Donald J. Kyle	6750-173-999	5149
20583	7590	07/11/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			WARD, PAUL V	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/607,563		KYLE ET AL.	
	Examiner		Art Unit	
	PAUL V. WARD		1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-236 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-236 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. The compounds and compositions according to claims 1-22, of Formula I.
These are classifiable in class 546, subclass various.
- II. The compounds and compositions according to claims 23-41, of Formula II.
These are classifiable in class 544, subclass various.
- III. The compounds and compositions according to claims 42-63, of Formula III.
These are classifiable in class 544, subclass 242.
- IV. The compounds and compositions according to claims 64-82, of Formula IV.
These are classifiable in class 544, subclass 233.
- V. The compounds and compositions according to claims 83-99, of Formula V.
These are classifiable in class 548, subclass 100+.
- VI. The compounds and compositions according to claim 100, of Formula VI.
These are classifiable in class 544 or 548, subclass various.
- VII. The compounds and compositions according to claim 101, of Formula VII.
These are classifiable in class 544 or 548, subclass various.
- VIII. The method of treating according to claims 117-206 that relates to Formula I. The claims are drawn to a method of treatment that is classifiable in class 514.
- IX. The method of treating according to claims 117-206 that relates to Formula II.
The claims are drawn to a method of treatment that is classifiable in class 514.

- X. The method of treating according to claims 117-206 that relates to Formula III.
The claims are drawn to a method of treatment that is classifiable in class 514.
- XI. The method of treating according to claims 117-206 that relates to Formula IV.
The claims are drawn to a method of treatment that is classifiable in class 514.
- XII. The method of treating according to claims 117-206 that relates to Formula V.
The claims are drawn to a method of treatment that is classifiable in class 514.
- XIII. The method of treating according to claims 117-206 that relates to Formula VI.
The claims are drawn to a method of treatment that is classifiable in class 514.
- XIV. The method of treating according to claims 117-206 that relates to Formula VII.
The claims are drawn to a method of treatment that is classifiable in class 514.
- XV. The method of preparing according to claims 222-236 that relates to Formula I.
The claims are classifiable in class 548 and 544.
- XVI. The method of preparing according to claims 222-236 that relates to Formula II. The claims are classifiable in class 548 and 544.
- XVII. The method of preparing according to claims 222-236 that relates to Formula III. The claims are classifiable in class 548 and 544.
- XVIII. The method of preparing according to claims 222-236 that relates to Formula IV. The claims are classifiable in class 548 and 544.
- XIX. The method of preparing according to claims 222-236 that relates to Formula V. The claims are classifiable in class 548 and 544.
- XX. The method of preparing according to claims 222-236 that relates to Formula VI. The claims are classifiable in class 548 and 544.

- XXI. The method of preparing according to claims 222-236 that relates to Formula VIII. The claims are classifiable in class 548 and 544.
- XXII. The kit according to claims 207-210 of Formula I. The claims are classifiable in class 206, subclass 569.
- XXIII. The kit according to claims 211-212 of Formula II. The claims are classifiable in class 206, subclass 569.
- XXIV. The kit according to claims 213-216 of Formula III. The claims are classifiable in class 206, subclass 569.
- XXV. The kit according to claims 217-218 of Formula IV. The claims are classifiable in class 206, subclass 569.
- XXVI. The kit according to claim 219 of Formula V. The claims are classifiable in class 206, subclass 569.
- XXVII. The kit according to claim 220 of Formula VI. The claims are classifiable in class 206, subclass 569.
- XXVIII. The kit according to claim 221 of Formula VII. The claims are classifiable in class 206, subclass 569.

The composition claims will be examined along with each elected compound group, respectively.

Inventions of Group I-VII and VIII-XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially

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different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product, such as iminopiperazine compounds.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I-VII and Group XV-XXI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process claimed can be used to make other and materially different products.

The inventions of Groups I-XXVIII are separate and patentably distinct because there is no patentable co-action among them and a reference anticipating one member will not render another obvious.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, a search of the four groups designated above would impose an undue burden upon the examiner, and restriction for examination purposes as indicated is proper.

Rejoinder Advisory

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

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In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

A telephone call was made to Sam Abrams on June 26, 2006, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is requested to elect a specifically disclosed species of the invention to be examined for search purposes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James O. Wilson
Supervisory Patent Examiner
Technology Center 1600